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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/910,246 | 07/20/2001 | Chet L. Andrews | VLTI.79914 | 1646 |
| 5251 | 7590 | 10/11/2006 | EXAMINER | |
| SHOOK, HARDY & BACON LLP INTELLECTUAL PROPERTY DEPARTMENT 2555 GRAND BLVD KANSAS CITY, MO 64108-2613 | | | BORLINGHAUS, JASON M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3693 | |

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/910,246 | ANDREWS ET AL. |
| | Examiner | Art Unit |
| | Jason M. Borlinghaus | 3693 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 7/20/01 & 1/11/02.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-22 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 20 July 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/11/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 4 is objected to because of the following informalities: improper capitalization. Applicant improperly capitalizes "E-merchant" and "Web server". Appropriate correction is required.

Claims 8 – 9 and 15 - 16 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 utilizes a slash-mark between two claim limitation terms, and examiner is unable to ascertain whether such punctuation indicates alternative claim limitations or is merely stating synonymous claim limitations, as perceived by the applicant.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 – 9 and 17 - 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalakota (Kalakota, Ravi & Whinston, Andrew B. *Electronic Commerce: A Manager's Guide*. Addison-Wesley. 1997. pp. 157, 160 – 161, 163 – 167, 170, 193 – 195, 337 and 376).

Regarding Claims 1 - 7, Kalakota discloses a method for a payment settlement process that electronically originates a paper check settlement for online transactions comprising the steps of:

- obtaining necessary personal and financial information to allow check creation (registration information and electronic check information). (see p. 165);

Art Unit: 3693

- obtaining a guarantee of the funds (bank-certified cashier's check/check guarantee system). (see p. 160);
- transferring check print information to a check printing service (Intuit will print and mail a physical check). (see p. 195);
- transferring check information to a depositing bank (Payee bank). (see pp. 165 – 166);
- providing confirmation of transaction to all parties (consumer receives confirmation number - see p. 195; payee receives statement/notification – see p. 166);
- generating records and materials (properly signed and endorsed checks) necessary to effectuate a deposit of funds into the proper account (settle accounts). (see p. 165);
- providing information (statement) on fund deposits. (see p. 166);
- selecting an icon ("PAY" button) that is located on the e-merchant's web page (merchant server). (see p. 170);
- transferring control and information to a host web server (Intuit/National Services Processor/accounting server). (see pp. 166; 193 – 195);
- said necessary personal and financial information (names and amounts of payees/account holder information) to allow check creation is directly obtained from the consumer (see pp. 165 and 195);

- sending purchase amount and personal information (check – containing account holder and payment amount information) to a third party check verifying/guarantee vendor (accounting server). (see pp. 165 – 166);
- receiving a response (notification) from said third party vendor (accounting server). (see p.166);
- posting (sending) a payment transaction (payment instructions) to a database server (bank computer). (see p. 166);
- forwarding an e-merchant transaction tag and third party approval (notification from accounting server) to an e-merchant (payee). (see p. 166);
- obtaining said instructions to print a paper check. (Intuit will print a physical check). (see p. 195);
- printing said paper check (see p. 195) ; and
- depositing said check into the account of said e-merchant (at payee's bank). (see p. 166).

Kalakota does not teach underlined claim limitations – a method comprising the steps of:

- providing an option to pay by check;
- said necessary personal and financial information to allow check creation is recalled from a previous consumer transaction;
- displaying said response to the purchaser;
- prompting the purchaser for final acceptance of the transaction;

- obtaining said e-merchant instructions to print a paper check; and
- depositing said paper check into the account of said e-merchant.

While Kalakota does not expressly disclose that an option is provided to the consumer to pay by check, Kalakota does disclose that Quicken software "looks at each payee and determines the correct method to handle the transaction" (see p. 195), and providing a consumer an option to pay by check is old and well known in the art of financial services and/or financial transactions. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Kalakota by incorporating the ability to provide an option to pay by check, as is old and well known in the art, and selecting such method to handle the transaction if such method was offered, as disclosed by Kalakota, allowing the consumer the opportunity to utilize a check as an acceptable payment method.

While Kalakota does not expressly disclose that said information is recalled from a previous consumer transaction, Kalakota does disclose that "users must register with a third-party account server before they are able to write electronic checks" (see p. 165) and retrieval of necessary information from previous transactions is old and well known in the art of information technologies. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Kalakota by incorporating the ability to recall information from a previous consumer transaction, as is old and well known in the art, such as information entered during the registration phase, as disclosed by Kalakota, allowing the user the respite from having to reenter the same information during each transaction.

While Kalakota does not expressly disclose displaying a response to the purchaser, Kalakota does disclose displaying a response (verification notification and/or bank statement confirming deposit) to payee (see p. 166), it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Kalakota to allow for display of such information to any party to the transaction that the inventor desired. *In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

Prompting a purchaser and/or system user to confirm an online transaction prior to completion of said transaction is old and well known in the art of information systems. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Kalakota to have prompted the purchaser for final acceptance of the transaction prior to completion, as is old and well known in the art, to confirm that the purchaser wishes to complete said transaction.

While Kalakota does not expressly state that it obtains e-merchant instructions to print a check, Kalakota does disclose that Quicken software “looks at each payee and determines the correct method to handle the transaction” (see p. 195), and provides an instance in which it prints a paper check for a payee (Macy’s) that is unable to receive electronic funds (see p. 195). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Kalakota by incorporating the ability to receive instructions from an e-merchant concerning the printing of a paper check, as Kalakota does determine “the correct method to handle the transaction.”

Regarding Claims 8 - 9, Claims 8 - 9 recite similar limitations and/or would have been obvious based upon Claims 1 – 7 rejected above, and are therefore rejected using the same art and rationale as applied in the rejection of Claims 1 - 7.

Regarding Claims 17 - 18, Claims 17 - 18 recite similar limitations and/or would have been obvious based upon Claims 1 – 7 rejected above, and are therefore rejected using the same art and rationale as applied in the rejection of Claims 1 - 7.

Regarding Claims 19 - 22, Kalakota discloses a method for handling the settlement of checks comprising:

- identifying a forwarding account (third-party account server allowing electronic checks). (see p. 165);
- funding said forwarding account (require a credit card or a bank account to back the checks from third-party account server). (see p. 165);
- returning check items (authorizing transfers) against said forwarding account (electronic check account). (see p. 165); and
- wherein said identifying includes having a merchant select to guarantee (via a check guarantee service) a deposit to a first bank. (see p. 160).

Kalakota does not teach underlined claim limitations – a method comprising:

- wherein said identifying includes having a merchant select to guarantee a deposit to a first bank by identifying a second bank account for charge back items;
- wherein said funding of said forwarding account is by one or more check guarantee service; and

- wherein said funding of said forwarding account includes the deposit of fees payable to the guarantee service.

Utilization of forwarding and/or linked financial accounts and the direction of financial transactions, either deposits or withdrawals, to such accounts is old and well known in the art of financial services and financial transactions. It would have been obvious to one of ordinary skill in the art at the time invention was made to have modified Kalakota to allow for any party to the transaction to utilize a forwarding account that the inventor desired, both the payer (as disclosed by Kalakota) and/or the payee.

In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

Charge back items and/or refunds charged against the merchant and merchant selection of a guarantee for said charge back items and/or refunds are old and well known in the art of financial services and financial transactions. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Kalakota by incorporating a guarantee service to protect against the possibility of charge back items, providing the merchant insurance against the possible financial losses relating to charge back items.

Receipt of payment from a check guarantee service and/or payment for the protection of a check guarantee service is old and well known in the art of financial services and financial transactions. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Kalakota by incorporating the payment of funds to or the receipt of funds from a guarantee service, as such

transfer of funds is standard and/or conventional in the provision of financial services by a third party.

Claims 10 – 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowrey (Lowrey, Joseph. *Buying Online for Dummies*. IDG Books. 1998. pp. 164 – 168) in view of Kalakota, as in Claims 1 – 9 above.

Regarding Claims 10 - 14, Lowrey discloses a method in a computer system having a graphical user interface including a display for displaying and a means for enabling entry of a plurality of purchaser informational items in the computer system, said method comprising:

- displaying a check image. (see p. 167, figure 10-1);
- displaying a plurality of labels (buttons) and alphanumeric entry boxes (textboxes) for prompting and accepting said purchaser informational items. (see pp. 164 – 167);
- wherein displaying of said check image comprises:
 - displaying a purchaser name (see p. 167, figure 10-1);
 - displaying a check number. (see p. 167, figure 10-1);
 - displaying a check date field. (see p. 167, figure 10-1);
 - displaying a check amount field. (see p. 167, figure 10-1);
 - displaying a payee name field. (see p. 167, figure 10-1);
 - displaying an MICR-line. (see p. 167, figure 10-1);
 - displaying a signature entry field. (see p. 167, figure 10-1);

- wherein the means for entry of information by a purchaser is on a displayed keypad (Cybercash keypad), wherein said keypad has a plurality of buttons and wherein said buttons depict characters and symbols found on a paper check. (see p. 167, figure 10-1); and
- wherein said check image is arranged and displayed in a similar format as a paper check. (see p. 167, figure 10-1).

Lowrey does not teach underlined claim limitations – a method:

- wherein displaying of said check image comprises:
 - displaying a check date;
 - displaying a check amount;
 - displaying a payee name;
 - displaying a payee address;
 - displaying a signature entry;
- wherein the means for entry of information by a purchaser is with a keyboard.

Inclusion and/or provision of a check date, check amount, payee name and signature entry on a paper check is old and well known in the art of financial transactions and financial services. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Lowrey to display the same information, as is old and well known in the art, on the displayed electronic check as would have been displayed on the paper check, allowing for the electronic check to

"work in much the same manner as a conventional paper check." (see Kalakota, p. 165).

Inclusion and/or provision of a payee address would have been obvious for transmission of the check to the payee, whether an electronic address allowing transmission of an electronic check (see Kalakota, p. 166) or a physical address allowing mailing of a paper check (see Kalakota, p. 195). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Lowrey by incorporating the provision and/or display of a payee address, as such address would be utilized for transmission of said check to payee.

Utilization of a keyboard as a means of entry of information by a user into a computer system is old and well known in the art of information systems. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Lowrey and Kalakota by incorporating a keyboard as an input device, as keyboards are a standard and/or conventional technology for inputting information into a computer system.

Regarding Claims 15 - 16, Claims 15 - 16 recites similar limitations and/or would have been obvious based upon Claims 10 – 14 rejected above, and are therefore rejected using the same art and rationale as applied in the rejection of Claims 10 – 14.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



ELLA COLBERT
PRIMARY EXAMINER